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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,316	11/04/1999	GARY PARSONS	XM-0015	5074

7590

09/06/2002

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EXAMINER

BAYARD, EMMANUEL

ART UNIT

PAPER NUMBER

2631

DATE MAILED: 09/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/435,316

Applicant(s)

PARSONS ET AL.

Examiner

Emmanuel Bayard

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 1999.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Farris et al U.S. Patent No 6,167,253.

As per claims 1, 15 and 25, Farris et al discloses a receiver comprising: a first means for receiving (see figs. 2, 4-7 elements 2, 80, 2b, 2c and col.4, line 27 and col.16, lines 53-64) a transmitted signal and providing an instantaneous output signal in response thereto; a second means for storing (see fig.4 element 82 and col.17, lines 1, 20-25) an audio signal. Note that, in

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col.4, lines 27-28, Farris teaches a means receiving data, voice mail and audio signal. Therefore by storing only the audio signal corresponds to the claimed (at least a portion) of said received signal; third means (see fig.4 elements 58 or 60 and col.16, lines 36-37) for providing a microphone. Note that in page 7, lines 8-19, the replay signal is defined as a simple button or a microphone , therefore the microphone or button of Farris corresponds to the claimed (replay signal); and fourth means (see fig.4 element 68 and col.16, lines 62-67 and col.17, lines 6-16) for selectively outputting said stored portion of said received signal or said instantaneous output signal in response to said replay signal.

As per claim 2, the receiver of Farris does include a radio frequency tuner (see fig.7 element 122 and col.21, line 21).

As per claim 3, the receiver of Farris does include an audio decoder (see fig.4 element 84 and col.17, lines 25-26).

As per claim 4, the receiver of Farris does include an user interface (see fig.2 element 40 and col.15, line 58).

As per claim 5, the receiver of Farris does include a system controller (see figs.4, 7 elements 68, 98).

As per claims 6 and 16, the receiver of Farris does include a microprocessor (see fig.7 element 104).

As per claims 7 and 17, the receiver of Farris does include a software (see col.19, line 65).

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As per claims 8-14, 18-24 and 26-32, the receiver of Farris does include a software for detection of codes (see col.37, lines 61-67 and col.38, lines 61-67 and col.43, lines 59-67).

### *Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harper et al U.S. Patent No 5,585,858 teaches a simulcast of interactive signals with a conventional video signal.

Ruhl U.S. Patent No 6,018,649 teaches a RDS-TMC receiver.

Freeman et al U.S. Patent No 5,861,881 teaches an interactive computer system.

Okamoto U.S. Patent No 6,064,441 teaches a receiving method and apparatus.

Takahisa et al U.S. patent No 5,812,937 teaches a broadcast data system.

Hall U.S. Patent No 6,021,325 teaches a mobile telephone.

Murata U.S. Patent No 6,285,872 B1 teaches a digital radio telephone for a digital mobile radio.

Boreth U.S. Patent No 6,340,997 B1 teaches a worldwide television tuning system.

Reitmeier U.S. Patent No 6,118,498 teaches a channel scanning and channel change.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Bayard whose telephone number is (703) 308-9573. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'Emmanuel Bayard', with a long horizontal stroke extending to the right.

Emmanuel Bayard

Patent Examiner

August 31, 2002